

REMARKS

Claims 1-3, 5, 8, 15, and 16 have now been rejected under Section 103(a) based on the combination of (1) Page (US Patent No. 5,565,149), (2) Harris (US Patent No. 4,160,727), and (3) Voznick (US Patent No. 5,256,279).

Applicant respectfully traverses this rejection, as it is based on an improper combination of references. It is improper because it violates the well settled principle of law that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Hindsight Claim Reconstruction is Improper

In analyzing obviousness questions, "[e]ffort must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims . . .'" (internal citation omitted). *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Federal Circuit "case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *Ecolochem, Inc., v. Southern California Edison Company*, (Circuit Judge Michel in an unpublished 2000 Federal Circuit opinion, citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re*

Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). Furthermore, "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

In the rejection, the Examiner cites column 5, lines 58-64 of the Page reference to support a conclusion that Page suggests reverse osmosis water treatment ("RO"). However, as was discussed in Applicant's last response, that passage in Page merely suggests degassing, and not RO. It is wrong to equate degassing with RO. Indeed, the Examiner's reference to "dangerous impurities" betrays that hindsight analysis was used to create this rejection – that is, that the claimed invention was used as a blueprint for finding the various pieces. Clearly, because the Examiner was using the idea of "dangerous impurities" in his search for references, an idea that Page's degassing has nothing to do with, he was using Applicant's solution as his guide. To create a valid rejection, however, the references themselves – and not Applicant's disclosure – must supply the motivation to combine. The degassing reference in Page just does not provide that motivation, as it has nothing to do with "dangerous impurities," because it is not that kind of water treatment – it is directed at adjusting partial pressures for better carbonation, and so could not motivate a combination with RO. Instead of using motivations found in the prior art to create Applicant's invention, the Examiner used Applicant's disclosure to find pieces that were then jammed together without proper justification.

This kind of loose analysis, made in an effort to piece together prior art references, is precisely what the Federal Circuit demands we guard against in obviousness questions. One cannot simply latch on to a statement that degassing may be desirable, and equate that to a motivation to combine Page with reverse osmosis. Such an approach does not satisfy the rigor required by Federal Circuit law, and is a clear example of improper conclusory rejection, unsupported by the detailed analysis required of Examiners (as discussed in detail in the next section). Simply stated, the degassing suggestion does not motivate one to consider reverse osmosis. Furthermore, there is nothing in Harris that would suggest its combination with a dispenser that allows for carbonation, and in particular hollow fiber carbonation, and even more particularly with a flexible reservoir. Thus, neither reference suggests combination with the other, and the claims should be allowed.

Moreover, the question presented is not only whether there is a motivation to combine water treatment references and hollow fiber carbonation references, but whether the combination of each of such elements with a flexible reservoir would be obvious. To make the rejection, the Examiner was compelled to bring in another reference, the Voznick reference. And, because it would be so clearly improper to make a rejection by trying to combine Voznick and Page alone, the Examiner recognized the need for the intermediate reference of Harris, making a total of *three* references. However, there is no motivation to combine the Voznick reservoir with a beverage dispenser that uses hollow fiber carbonation and RO water treatment. The references just do not teach, suggest, or motivate their combination, and it is clear that the claimed invention has been used as a blueprint to piece together these references, in contravention of Federal Circuit law. The issue is whether the claimed invention

as a whole would have been obvious, and not whether a string of references can be laced together to form the invention.

With regard to Claims 5 and 16, the rejection is based on the above three references, *plus* a conclusion that chilling is notoriously well known. However, this conclusion reveals – once again – the fundamentally improper way in which these rejections are being formulated. The question is not whether chilling is known in carbonation systems. Rather, it is whether chilling of water in a flexible reservoir in combination with all other elements is obvious. As mentioned earlier, the issue is whether the claimed invention *as a whole* would have been obvious, and not whether a hodgepodge of references can be laced together to form the invention. *Stratoflex*.

Inc. v. Aeroquip Corp., 713 F.2d at 1537; *Schenck v. Nortron Corp.*, 713 F.2d 782, 785 (Fed. Cir. 1983); *see also, In re Hirao*, 535 F.2d 67, 69 (CCPA 1976) (requiring an analysis of the subject matter *as a whole*).

A Prima Facie Case of Obviousness Has Not Been Made

Furthermore, the Examiner has the burden of showing a *prima facie* case of obviousness. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If such a showing is not made, the rejection must be withdrawn. As made clear by the case law and MPEP Sections §§ 2143 and 2143.01-03, to establish such a *prima facie* case, the Examiner must show that there is some objective suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The mere assertion by the Examiner that it would have been obvious “to substitute the reverse osmosis water treatment system of Harris, Jr. for the water

degassing pretreatment of Page” does not carry the Examiner’s burden of making a *prima facie* showing of obviousness, and thus is not sufficient for a Section 103 rejection. “Either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). It is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986); MPEP § 2142. Without reasonably specifying the reasons for the rejection, the examiner procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). The showing of obviousness must be “clear and particular,” and “broad conclusory statements regarding the teaching” of the prior art are not evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Also, the showing of a teaching, suggestion, or motivation is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed Cir. 1998). Here, the Examiner’s statement is not just inappropriately conclusory, it is wrong, as reverse osmosis is not an appropriate substitute for Page’s degassing.

For all of these reasons, it is respectfully submitted that Claims 1-3, 5, 8, 15, and 16 are allowable.

Other Claim Rejections

Claims 4, 9-14, and 19-20 have been rejected for additional reasons. Because these depend from claims that Applicant submits are allowable, they too should be allowed based on the arguments above. Following are additional reasons for their allowance.

Claim 4 was rejected based on the above three references plus a *fourth* reference, Katou (US Patent No. 6,158,721). Katou is directed to controlling the resistivity of water for semiconductor processing applications, and thus is inappropriate to cite in a rejection, as it is from a non-analogous field. Furthermore, all the arguments above apply as well to the rejection of Claim 4, as it is improper to combine all those references and then Katau too in an effort to piece the claimed invention together. Thus, it is respectfully submitted that Claim 4 should be allowed.

Claims 9-14, 19 and 20 were rejected based on the three references discussed above, plus a *fourth* reference, LaRocco. LaRocco is for use in a bottling plant, not a dispenser, as claimed (particularly with the recitation of a customer interface as in Claim 1). Furthermore, all the arguments above apply as well to the rejection of these claims, as it is improper to combine all those references and then LaRocco too in an effort to piece the claimed invention together. Thus, it is respectfully submitted that Claims 9-14, 19, and 20 should be allowed.

Claims 21 and 22 were rejected under Section 103(a) based on the combination of Page and Katou. However, the Katou reference is directed to controlling the resistivity of water for semiconductor processing applications, and thus is inappropriate to cite in a rejection, as it is from a non-analogous field. It is not related to the beverage dispensing arts. Moreover, it provides no suggestion or motivation to use it in combination with a beverage dispenser as claimed, and the Examiner's reference to column 7, lines 40-52 is inappropriate as it does not address the fundamental issue that Katou is non-analogous art and it simply inappropriate to cite. Furthermore, the Page reference is specifically directed to flowing gas through fibers, with a strong emphasis on having the liquid on the shell side. It in no way suggests, and indeed teaches away from, the opposite, which is claimed in Claim 21.

(flowing water through the fibers). It is inappropriate for the Examiner to build a rejection by picking and choosing various unrelated references which may show the claimed elements, but which provide no suggestion or motivation to combine them. As for Claim 22, water treatment is not suggested by the cited references, and thus is allowable. Thus, it is respectfully submitted that Claim 21 and dependent Claim 22 are allowable.

Claim 23 was rejected based on the three references Page, Katou, and Harris. As discussed above, the combination of Harris and Page is inappropriate because Page does not motivate any combination with reverse osmosis, and, even if it did, the combination with Katou is inappropriate as it is non-analogous art. Moreover, Claim 23 depends from allowable Claim 21, and it is respectfully submitted that it be allowed as well.

Claim 24 was rejected based on the three references Page, Katou, and LaRocca. As discussed above, Larocca deals with a bottling plant, and not a dispenser. Moreover, as Claim 24 depends from allowable Claim 21, it is respectfully submitted that it be allowed as well.

Applicant respectfully requests allowance of all outstanding claims. If the Examiner has any questions concerning this amendment, he is respectfully requested to call Dennis Braswell at the telephone number set forth below.

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